Supreme Court, U.S.
FILED
JAN 9 1998
CLERK

No. 97-881

IN THE

Supreme Court of the United States

OCTOBER TERM, 1997

MACRCHON EYEWEAR, INC., *et al.*,

Petitioners,

v.

TURA LP AND BROADART CO.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Petitioners' statement of the question presented fails to raise their question within the specific factual context of this particular case. Properly stated, the question presented is nothing more than whether the Court of Appeals for the Federal Circuit correctly reversed the judgment below when the trial judge erroneously relied upon trial testimony to construe terms in the patent claims in a manner which conflicted with the language of the patents' specifications and representations made by the inventors to the U.S. Patent and Trademark Office during patent prosecution and reexamination.

RULE 29.6 STATEMENT

The respondents, Tura LP and Brodart Co., do not have any parent companies or nonwholly-owned subsidiaries.

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PRELIMINARY STATEMENT

This case presents no issue worthy of review by the Supreme Court. The decision below does not conflict with the decision of any other court, involves no issues of constitutional law, and presents no important questions of federal law. The case is merely an instance of an appellate court reviewing a judgment of patent infringement entered after a jury trial and determining, in accordance with established standards of review and in the specific context of the particular patents involved, that the judgment of infringement was unsupported by the evidence and contrary to law.

The question of the appropriate standard for reviewing a district court's interpretation of terms in a claim of a patent necessarily was decided by this Court in *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1387 (1996), wherein this Court unambiguously held that "the construction of a patent, *including terms of art within its claims*, is exclusively within the province of the court." [Emphasis added.] Petitioners now request this Court to find that claim construction is an issue of fact subject to Rule 52(a) of the Federal Rules of Civil Procedure, when this Court clearly has held that it is not. This Court plainly recognized in *Markman* the benefits to the judicial process of treating "interpretative issues," such as construction of patent claims, "as purely legal." *Markman*, 116 S. Ct. 1396. Having decided that claim construction will be treated as an issue of law for a court - not an issue of fact for a jury - and having affirmed the Court of Appeals for the Federal Circuit, this Court signaled the application of general appellate rules with respect to the standard of review applicable to questions of law. Under well established appellate jurisprudence, questions of law, including questions of patent claim construction, are subject to a *de novo* standard of review.

Thus, the fundamental premise of the Petition is flawed: the issue presented is not an important unresolved issue.

Indeed, the Federal Circuit's *in banc Markman* decision, which this Court affirmed, expressly held that "[b]ecause claim construction is a matter of law, the construction given the claims is reviewed *de novo* on appeal." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)(in banc), *aff'd*, 116 S. Ct. 1384 (1996). The Petition fails to provide any compelling reasons for the exercise of this Court's discretion or any valid reason why this Court now should revisit its unanimous decision in *Markman*.

Moreover, even assuming *arguendo* that there could be policy reasons which favor appellate deference to district court determinations about the meaning of technical terms in patent claims in an appropriate case, such policy reasons are not implicated by the facts of this case. This is not a case where the patent specifications and accompanying prosecution histories are either silent or ambiguous about the meaning of the patent claim terms in question and resort to the extrinsic trial testimony is either necessary or useful in order to determine the meaning of such terms. On the contrary, the Federal Circuit found that the patent specifications clearly suggested the claim construction adopted by appellate court, and that the inventors expressly embraced this construction in statements made to the U.S. Patent and Trademark Office during the course of patent prosecution and reexamination to obtain allowance of their claims. Under the circumstances, it was not error for the Federal Circuit to decline to defer to the trial court, which improperly credited extrinsic trial testimony which contradicted the objective, controlling public record set forth in the patent specifications and prosecution histories of the patents-in-suit.

COUNTERSTATEMENT OF THE CASE

The petition for writ of certiorari is particularly meritless because of its one-sided, incomplete, and therefore

misleading characterization of the trial record. The following counterstatement of the case should serve to correct any erroneous impressions created by the petition.

A. The Patents and Their Prosecution Histories

Although Petitioners assign error to "[t]he Federal Circuit's out-of-hand rejection of expert evidence of the meaning of claim terms to persons skilled in the relevant art," Pet. at 20, the propriety of the Federal Circuit's actions can only be evaluated in light of the undisputed public record surrounding the prosecution of the patents-in-suit. Since Petitioners are content to rely upon the fact that the trial court adopted the definition of the disputed claim terms ("3% elasticity" or, in claim 1 of the '112 patent, "4% elasticity") advocated by its expert at trial, it barely discusses the patents themselves or their prosecution histories. Yet it was precisely because this objective evidence contradicted the testimony of Petitioners' expert that the Federal Circuit was compelled to reverse the trial court's judgment as a matter of law.

As noted by the Federal Circuit, the eyeglass frames of claim 1 of the patents-in-suit are different from the frames of claim 5. Claim 1 requires, *inter alia*, a frame in "the work-hardened pseudoelastic metallurgical state" exhibiting either 3% or 4% elasticity over a specified temperature range, whereas claim 5 requires a frame "in the work-hardened and heat treated condition" exhibiting a combination of at least 3% heat-recoverable shape-memory and 3% elasticity without regard to a temperature range. (Pet. App. at 24a).

1. The Patent Specifications

Under the "Background of the Invention," the inventors described the problem that their frames were intended to solve.

According to the inventors, the prior art shape-memory alloy frames would become permanently deformed when bent at high or low temperature. Consequently there was a need for frames that would ***completely and spontaneously recover*** from strains at any temperature in the range of -20°C to +40°C.:

> It is the purpose of the instant invention to provide eyeglass frames which (1) are highly resistant to ***permanent deformation***, or "kinking", over the full range of ambient temperatures, ***or*** (2) are sufficiently resistant to deformation ***and are readily restorable to the undeformed shape by heating*** . . . .
>
> To accomplish this purpose there is provided frames having portions thereof fabricated from shape-memory alloys which (1) have the combination of superelastic and work-hardened pseudoelastic properties, ***hereinafter "optimized elasticity" properties, or*** (2) exhibit a ***combination*** of shape-memory and elastic properties . . . . (C.A. App. 6418, 2:21-34; emphasis added).[1]

As discussed below, CVI/Beta told the PTO that claims 1-4 of the patents in suit were directed to this first "optimized

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[1] Insofar as the '955 patent is a CIP of the '112 patent, the specifications of the two patents in suit are substantially similar. For sake of brevity, this brief will principally cite to the '955 patent specification, although an identical citation to the '112 patent specification is usually also available. Interestingly, even in their Petition, the Petitioners admit that the inventors received a patent on their "invention" of a frame "that resumes its ***original*** shape, either spontaneously or after warming to room temperature, after being deformed." (Pet. at 2; emphasis added).

elasticity" embodiment and that claims 5-8 of the patents were directed to the second "memory plus elasticity" embodiment.

a. Claim 1 - "Optimized Elasticity"

In their example of the claim 1 "optimized elasticity" embodiment in the '955 patent, the inventors described a frame which acts "***completely elastically*** up to strains of 6% or more" throughout the temperature range of interest. (C.A. App. 6420, 6:1-25; emphasis added). That frame was said to "support a stress of over 150 ksi (1,033 MPa) at 4% tensile strain and show ***complete elastic spring back*** at room temperature." (C.A. App. 6420, 6:1-25; emphasis added).

The '955 patent also describes how the alleged advantages of the claim 1 embodiments are obtained -- by work-hardening a pseudoelastic material. (C.A. App. 6420, 5:51-61; emphasis added; *see also* 5:61-68). In particular, Figures 2F (labeled "pure superelastic") and 2H (labeled "work hardened pseudoelastic") of the patents in suit show the behavior of the "optimized elasticity" embodiment of claim 1, i.e., ***complete recovery to original shape.*** (C.A. App. 6415; *see also* Pet. App. at 13a). Figure 2F shows the superelastic behavior of the frames at lower temperatures ($T<M_s$) and Figure 2H shows the work-hardened pseudoelastic behavior of the frames at higher temperatures ($M_s<T_2<M_d$). (C.A. App. 6419; 3:43-46, 51-54). In addition, the brief description of the drawings in both patents specifically defines the behavior shown in Figure 2H as "***optimized elasticity***" or "***Optimized Elastic.***" (C.A. App. 6419, 3:51-54; C.A. App. 6407, 3:25-27).

b. Claim 5 - "Memory Plus Elasticity"

As discussed above, the second alternative claimed frame embodiment in the patents-in-suit is fabricated from

shape-memory alloys that "exhibit a combination of shape-memory and elastic properties" so that the frames "are sufficiently resistant to deformation and are readily ***restorable to the undeformed shape by heating***." (C.A. App. 6418, 2:24-26, 33-34; emphasis added). The patent specifications assert that the addition of a "final" heat treatment to a work-hardened frame component is responsible for that combination of properties to give "a ***fully recoverable strain potential*** of at least 6%. (C.A. App. 6420, 6:35-43; emphasis added).

Such "[w]ork-hardening and partial annealing" is said to result in an alloy having the elastic behavior and memory characteristic as "shown in FIG. 2G." (C.A. App. 6420, 6:31-35; a copy of Figure 2G is reproduced in the Federal Circuit's decision at 13a). The "fully recoverable strain potential" of at least 6% is thus the claimed combination of at least 3% shape-memory plus at least 3% elasticity.

Significantly, unlike the example of a claim 1 embodiment where there was "complete" elastic spring back (C.A. App. 6420, 6:13-14), each example of a claim 5 component exhibited some amount of retained strain which could only be removed by heating the component. This is so because the component had been overstrained, i.e., the applied strain exceeded the component's inherent elasticity, so the component necessarily could only exhibit partial elastic recovery or spring back ***after the onset of permanent deformation.***

2. The Prosecution Histories

a. Original Prosecution

During the course of initial patent prosecution, the Examiner rejected claims 1-8 in the '112 patent application for

obviousness. (C.A. App. 6940-44). The inventors' attorneys and other representatives met with the Examiner for an interview in which they attempted to overcome this rejection. (C.A. App. 6961-66). The very first page of the Examiner's Interview Summary Record states:

> claim 1 -***optimized elastic*** (applicants' term)
> -useful over large temp. range, has comfort
> -does not ***deform*** in cold temps. . . .
> (C.A. App. 6961; emphasis added).

It is thus clear that the Examiner understood from his discussion with the inventors' agents that claim 1 covers "***optimized elastic***" eyeglass frame components and that they were useful precisely because they ***did not deform*** in cold temperatures. In contrast, the Examiner noted in connection with the attorneys' presentation in connection with claim 5 that, unlike a claim 1 component, a claim 5 component bends and then "***returns to shape*** w/heat." (C.A. App. 6962, emphasis added; see also the inventors' subsequent description of the interview, C.A. App. 6954).

The inventors subsequently filed a Response to Office Action (C.A. App. 6947-60), in which the inventors stated:

> Claims 1-4 are specific to Applicants' ***first embodiment*** of frame components with ***optimized elasticity.*** . . . Only by doing the proper work hardening to an alloy which has the pseudoelastic property *already* can one obtain the ***optimized elasticity*** combination of properties which utilize the soft elasticity of the pseudoelastic effect in concert ***with a resistance to turning weak and staying bent when***

> ***deformed*** at a temperature below the materials[']transformation temperature.
>
> The figure which ***illustrates this embodiment is Fig. 2H.***

(C.A. App. 6952-53; emphasis added). It is thus clear that the inventors specifically used the term "elasticity" in describing the full strain recovery graphically depicted in Figure 2H.

To overcome an obviousness rejection relating to claims 5-8 during the prosecution of the '112 patent, the inventors argued that their "careful choice" of processing steps, including a "long heat treatment at an unexpectedly low temperature," yielded the unobvious properties recited in claim 5. (C.A. App. 6955). Such frames "will exhibit adequate stiffness, a good springy feel, and significant sharp and ***complete shape-memory recovery when heated should the component be pushed past its springy limits and some deformation be retained.***" (C.A. App. 6955; emphasis added). This was directly contrasted with the invention of claim 1. The inventors noted that had the ***same*** material been "left in a fully work hardened condition, the properties shown in Fig. 2F would result, and the component would be very springy but would not give a ***complete*** shape-memory recovery ***if deformed past the component's elastic limit.***" (C.A. App. 6956; emphasis added).

In a second preliminary amendment filed in connection with the '955 patent application (C.A. App. 6726-28), the inventors amended claim 1 "to ***more clearly*** state that in the claimed embodiment referred to in the specification as the "***optimized elastic***" embodiment . . . [the component] is in the work-hardened pseudoelastic metallurgical state . . . . This "***optimized***" (a term coined by the Applicants) embodiment is

due to the work-hardening of a pseudoelastic material." (C.A. App. 6727; emphasis added).

The Examiner had also rejected, *inter alia*, claims 1-4 in the '955 application for obviousness-type double patenting. (C.A. App. 6741-43). In attempting to overcome the rejection in their Response to Office Action (C.A. App. 6753-55), the inventors unequivocally stated: (1) that "the behavior shown in FIG. 2H . . . is described as 'work-hardened pseudoelastic'"; (2) that work-hardened pseudoelastic behavior "is behavior which Applicants define as ***'optimized elastic'***"; and (3) that "***Applicants' invention is optimized elasticity***." (C.A. App. 6754; emphasis added; *see also* C.A. App. 6759-60).

b. Reexamination of the '955 Patent

In 1990, both parties sought reexamination of claim 1 of the '955 patent. (C.A. App. 6427-50; C.A. App. 6998-7002). In those proceedings, CVI/Beta reiterated to the Patent Examiner the significance of the stress-strain behaviors graphically depicted in Figures 2F and 2H as showing full recovery:

> If the alloy is exposed to temperatures above the M_s, the work-hardened pseudoelastic behavior of the alloy ensures that it retains ***the desired elasticity, as shown by Figure 2H*** of the '955 patent. . . . Below the M_s, the work-hardened structure will not undergo easy heat-recoverable strain as shown in Figure 2B but rather, exhibits ***the elastic behavior shown in Figure 2F*** of the '955 patent. (C.A. App. 6431-32; emphasis added.)

CVI/Beta also reiterated that "Claim 1 of the '955 patent covers an eyeglass frame having a component in the work-hardened pseudoelastic condition" which the applicants discovered has ***"optimized elasticity***." (C.A. App. 6432; emphasis added). As a result, "a pseudoelastic material will transform from austenite to martensite upon the application of stress and when the stress is removed, the martensite will transform back to austenite and the strain will ***spontaneously return to zero*** (See column 1, lines 53-55 of the '955 patent and column 3, lines 26-37 of U.S. Patent No. 4,533,411, Exhibit A)." (C.A. App. 6440; emphasis added).

Of special significance is the fact that CVI/Beta attempted to distinguish the invention of claim 1 from the alloy disclosed in the Mercier reference (C.A. App. 6507-13; C.A. App. 7024-31) because the Mercier alloy failed to exhibit complete recovery. It noted that "[t]he first part of the curve shown in Figure 4 of Mercier does not indicate that the sample tested was in the work-hardened pseudoelastic condition prior to testing since the sample exhibited 3% ***retained strain*** rather than ***return to zero strain*** when the load of 1150 N/mm^2 was removed." (C.A. App. 6441; emphasis added).

In attempting to distinguish the Mercier reference, the Petitioners explained the particular relevance of Figure 2H to the invention of claim 1. The Mercier sample "exhibit[ed] a 3% ***retained strain*** when the load of 1150 N/mm^2 is removed." (C.A. App. 6440; emphasis added). "Figure 2H of the '955 patent," in contrast, showed "how work-hardened pseudoelastic material covered by Claim 1 will behave at temperatures between M_s and M_d" and that "it can clearly be seen that the material is ***totally elastic*** when a stress of about 115 ksi is applied and removed." (C.A. App. 6440; emphasis added).

To avoid the Mercier reference's disclosure of a work-hardened pseudoelastic nickel-titanium alloy which exhibited 8.1% elastic springback from an 11.1% strain, leaving a 3% residual deformation, ***CVI/Beta expressly advocated a construction of "3% elasticity" in claim 1 as elasticity which occurs prior to the onset of permanent deformation such that there is no retained strain and the material can return to its original shape over a broad temperature range***:

> The 8.1% elasticity shown in Figure 4 of Mercier comes at the expense of a 3% retained strain, that is, the material will not return to its original shape. The material covered by Claim 1 of the '955 patent exhibits at least 3% elasticity over the temperature range -20°C to +40°C. ***The elasticity set forth in Claim 1 is attainable prior to the onset of permanent deformation. Otherwise, the recited elasticity properly [sic: property] would be meaningless.*** That is, ***elasticity*** measurements are used to indicate how much a material can be ***elastically*** deformed. Once a material is plastically deformed, it no longer will return to its ***original shape***. With respect to the data shown in Figure 4 of Mercier, if the sample prior to testing corresponded to a finished part, after applying a load of 1150 N/mm^2 and releasing the load, the part would be ***deformed*** such that it exhibited 3% ***retained strain***. In the context of eyeglass frames, a frame which is deformed by 3% strain yet exhibits 8.1% elasticity is of no value since the 3% ***permanent deformation*** would result in significant distortions in the original shape of the frame. (C.A. App. 6445; emphasis added).

Finally, CVI/Beta referred to a textbook -- Mechanical Metallurgy, by G.E. Dieter, Jr. (C.A. App. 6516-22) -- for the definition of elasticity. (C.A. App. 6443.) According to that textbook, "[t]he ***recovery of the original dimensions of a deformed body when the load is removed is known as elastic behavior.*** . . . If the elastic limit is exceeded, the body will experience a ***permanent*** set or deformation when the load is removed." (C.A. App. 6518; emphasis added.)

B. Proceedings Below

1. Petitioners fail to mention that, shortly before trial, the trial judge in ruling on pending motions for summary judgment agreed with Respondents that "3% elasticity" meant complete recovery or springback to the frame's original length when the frame had been subjected to a 3% strain.[2] This is significant, as this earlier decision (C.A. App. 1081-166) was based primarily upon the intrinsic evidence set forth in the patent specifications and prosecution histories, uninfluenced by the subsequent jury verdict of infringement or the extrinsic trial testimony of Petitioners' expert, Dr. Beshers.

2. Petitioners relied at trial upon the testimony of its expert, Dr. Beshers, to establish the meaning of the technical term "3% elasticity" to persons skilled in the art at the time the invention was made. (Pet. at 5-6). While it may be true that Dr. Beshers devoted himself to the study of this issue in

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[2] *See, e.g.*, C.A. App. 1099 ("elasticity refers to the ability of a metal to resist permanent deformation and return to its original shape" after being stressed); C.A. App. 1102-03 (prior art did not "suggest that full recovery from a 3% strain can be maintained over the sixty-degree temperature range claimed"); C.A. App. 1104 (prior art did not "describe complete elasticity over the sixty-degree temperature range specified in the patents"); C.A. App. 1151 ("3% elasticity" permits 100 cm rod pulled to 103 cm "to return to its original length of 100 centimeters" after force is completely released).

connection with this litigation, he nonetheless testified that he had no experience with memory shape alloys until he was hired in connection with this lawsuit, a date several years after the patents-in-suit had issued, that he had no experience with regard to eyeglass fabrication, and that despite such study he had no idea what "elasticity" meant to those people in the particular trade of manufacturing eyeglass frames. (Pet. App. at 56a and 57a n.11; C.A. App. 3952, 4058, 4161).

While Dr. Beshers was willing to testify that, in his opinion, a 100 millimeter frame component stretched to 200 millimeters which "springs back" to 97 [sic:197] millimeters upon release of the stress -- and thus exhibits a 97% retained strain -- would meet the elasticity limitation of the '955 patent (C.A. App. 4157-58; see also Pet. App. at 56a n.10), this was directly at odds with his own testimony and that of others which acknowledged that a commonly accepted definition of "elasticity" was the ability of a stressed material to return to its original shape upon removal of the stress. (*See* C.A. App. 4160-67 (Beshers); C.A. App. 3572-74 (Krumme); C.A. App. 5235-36 (Johnson); C.A. App. 4639-41 (Suzuki)). Various other dictionary definitions are in accord. (*See, e.g.*, C.A. App. 4158, 5235, 5296).

3. Petitioners attempt to rely upon the grant of a preliminary injunction in another case, *CVI/Beta Ventures, Inc. v. Custom Optical Frames, Inc.*, 893 F. Supp. 508 (D. Md 1995), *aff'd*, 92 F.3d 1203 (Fed. Cir. 1996)(unpublished), to bolster their position. (Pet. at 8-9). What Petitioners fail to inform the Court is that only claim 1 of the '955 patent was involved in that appeal and the records in the two cases were in no way identical. (Pet. App. at 116a.) Significantly, no aspect of claim 5 of the '955 patent nor of any of the claims of the '112 patent were before the Federal Circuit for review in that interlocutory appeal.

The Federal Circuit made clear in its unpublished opinion that Custom Optical would "have an opportunity at the merits stage to present and expand upon the arguments it has made at the preliminary injunction stage, as well as any additional arguments that it chooses to present, and the district court will be able to give those arguments plenary consideration at that time." (Pet. App. at 119a (quoting *PPG Indus. v. Guardian Indus.*, 75 F.3d 1558, 1567 (Fed. Cir. 1996)). Petitioner settled its dispute with Custom Optical shortly thereafter, so a trial on the merits in that case never took place.

When faced with the amplified, complete record in this case, which focused on the relevant portions of the specifications and file histories of both patents, the Federal Circuit was at liberty to reassess its prior position based upon a district court's tentative claim construction and its resulting finding on the likelihood of successfully proving infringement. (Pet. App. at 26a n.7). Indeed, as noted by Petitioners, this Court in *Tilghman v. Proctor*, 102 U.S. 707, 708 (1881), overruled its own interpretation of a patent in *Mitchell v. Tilghman*, 86 U.S. (19 Wall.) 287 (1874), when faced with a different evidentiary record. (Pet. at 20).

4. Petitioners contend that the Federal Circuit improperly modified the specification of the '112 patent by fiat to correct an obvious typographical error and that they were not given an opportunity to supplement the record on this point. (Pet. at 9-10 & n.2). As noted by the Federal Circuit, Petitioners had the ability and an opportunity to submit such evidence to the trial judge as well as to the Federal Circuit after Respondents raised the issue again in its opening brief on appeal, but failed to do so. (Pet. App. at 35a).

That it was a typographical error is clear from a reading of the '112 patent as a whole, as well as by the fact that

Petitioners' position cannot be reconciled with the presence of an *identical graph* bearing the correct designation in the related '955 patent. As noted by Petitioners, some 29 typographical errors were listed in the certificate of correction filed for the '112 patent, Pet. at 10, as this was a patent whose specification was riddled with errors when it was printed. The fact that this particular typographical error was not caught (or consciously ignored) by the Petitioners does not make it any less an error.

REASONS FOR DENYING THE WRIT

I. The Issue Presented by the Petition Was Decided by This Court in *Markman*

Petitioners essentially ask this Court to revisit the Court's decision in *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996), less than two years after it was decided. Petitioners ask this Court to raise extrinsic evidence to a new and dispositive level. According to Petitioners, whenever a trial judge credits extrinsic evidence, notwithstanding clear legal error in failing to consider properly a patent's specification or its prosecution history, the Federal Circuit must defer to the trial court's construction of disputed terms in a patent claim because it has become a factual determination subject to Rule 52(a) of the Federal Rules of Civil Procedure. Petitioners are wrong. Indeed, the very issue it now urges as an important unresolved issue was necessarily decided by this Court in *Markman*. A district court's construction of patent claim language is a question of law and as such it is subject to review *de novo*.

In its *in banc* decision in *Markman*, the Federal Circuit grappled with the issue of whether claim construction belonged to the jury as a matter of fact or was within the province of the

court as an issue of law. This was an important distinction for purposes of appeal "[s]ince matters of law must be reviewed *de novo* and matters of fact must be accorded substantial deference . . . ." *Markman*, 52 F.3d at 976. Reviewing precedent, fundamental principles of American law, and the interests of the patent system, the Federal Circuit plainly decided that claim construction was a question of law subject to *de novo* review. *Id.* at 976-79. Circuit Judge Mayer concurred in the judgment, expressing the lone view that clear error should be used to review facts found by the court. *Id. at 991.* This Court affirmed, and by doing so, answered the question now presented by the Petitioners: a district court's claim construction is accorded *de novo* review because it is to be treated as a question of law.

This Court's decision in *Markman* squarely addressed the issue "whether the interpretation of a so-called patent claim . . . is a matter of law reserved entirely for the court . . . ." *Markman*, 116 S. Ct. at 1387. It held that it was, specifically noting that this included "terms of art within its claims." *Id. See also Winans v. Denmead*, 56 U.S. (15 How.) 330, 338-39 (1854), which was discussed by this Court in *Markman*. 116 S. Ct. at 1392. Having determined that the interpretation of a claim of a patent is exclusively in the province of a court as a question of law, this Court necessarily concluded, as did the Federal Circuit, that the issue was subject to *de novo* review. As Judge Mayer's concurrence was before the Court, it is difficult to accept the Petitioners' argument that the Court was not approving of the Federal Circuit majority's approach.

Petitioners' claim that the issue of claim construction presents a mixed issue of law and fact, which should be treated as an issue of fact subject to the clearly erroneous standard of Fed. R. Civ. P. 52(a), ignores the holding by the *Markman* Court that all issues of claim construction will be treated as a

question of law for a court irrespective of any factual underpinnings in the decisional process. *Markman*, 116 S. Ct. 1395-96. Indeed, when this Court decided in *Markman* that the issue of claim construction is exclusively for a court as one of law (and not for a jury in any respect), this Court necessarily decided that the issue also is one of law for appeals purposes. It would be tantamount to legal sophistry to withhold an issue from a jury because it is a question of law, and then to transform the same issue into a question of fact on appeal when it is decided by a trial judge. Yet, that is the position urged in the Petition.

The distinctions for purposes of review between a matter of fact and a question of law is ingrained into our system of appellate jurisprudence. It is well settled that appellate courts accept findings of fact that are not clearly erroneous, but decide questions of law *de novo*. *First Options v. Kaplan*, 115 S. Ct. 1920, 1926 (1995); *Elder v. Holloway*, 510 U.S. 510, 516 (1994); *Pierce v. Underwood*, 487 U.S. 552, 558 (1988).

The Petitioners, however, maintain that such a rule "transform[s] claim construction into an antiseptic exercise that disregards trial court findings of the meaning of claim terms to persons skilled in the relevant art, in favor of abstract exegesis by appellate judges." (Pet. at 14.) This assertion rests on a fundamental misunderstanding of the appellate process and the role of a patent and its prosecution history in defining the meaning of claims. As discussed in detail in Part III below, there are indeed times when resort to extrinsic evidence is necessary and appropriate. However, both public policy and precedent require that the meaning of a patent claim be ascertained whenever possible from the patent itself and its prosecution history. Thus, irrespective of what practice the Federal Circuit may or may not follow in other cases where the meaning of a patent claim is ambiguous from reading the patent

and prosecution history, in this case the Federal Circuit followed *Markman* and reached the only decision which is consistent with the clear language of the patents-in-suit and their prosecution histories.

The Federal Circuit did not ignore the district court's decision. It carefully considered the district court's analysis and claims construction and found them flawed as a matter of law. The construction given the claims by the district court was inconsistent with the patent, and no quantum of extrinsic evidence can vary the meaning of a patent claim which is clearly evident from the patent and its prosecution history. This process of independent review is not a waste of judicial resources: it demonstrates the efficient functioning of the appellate system to reach the correct result in cases where issues of law are the subject of the appeal. *See Salve Regina College v. Russell*, 499 U.S. 225, 231-32 (1991). This approach has been consistently followed by the Federal Circuit since its decision in *Markman* was affirmed by this Court. *E.g.*, *Bell & Howell Document Management Prods. Co.* v. *Altek Sys.*, Appeal No. 97-1226, 1997 U.S. App. LEXIS 34253 at 12 (Fed. Cir. Dec. 5, 1997); *Engel Indus. v. Lockformer Co.*, 96 F.3d 1398, 1403-04 (Fed. Cir. 1996); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

II. The Federal Circuit's Decision is Fully in Accord With *Markman* and Other Decisions Of This Court.

The Federal Circuit in this case, in according independent review to a district court's construction of a claim, acted in accordance with - not contrary to - *Markman* and other Supreme Court decisions. This Court's decision in *Markman* very plainly and directly held that the interpretation of disputed claims of a patent is entrusted exclusively to a court as a matter

of law. As such, and as remarked by the Federal Circuit, it is subject to a *de novo* standard of review.

In *Markman*, this Court made it very clear that uniformity of decision was not served by submitting an issue of claim construction of a patent to a jury. *Markman*, 116 S. Ct. at 1396. Uniformity, however, clearly is served by independent review by the Federal Circuit, which is expert in patent matters, as this Court expressly recognized in *Markman*: "It was just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases . . . ." *Markman*, 116 S. Ct. at 1396 (citing H.R. Rep. No. 97-312, pp. 20-23 (1981)).

Thus, the Federal Circuit, which regularly hears patent appeals involving issues of claim construction every month, is uniquely in a better position that a trial judge, who may at best only preside over a handful of patent trials in the course of his or her lifetime, to decide patent claim construction issues and is not disadvantaged in claim construction by an inability to assess demeanor and credibility. The Federal Circuit rejected the trial court's claim construction, which rested on extrinsic evidence, because that construction did not comport with the patent documents as a whole.

The Federal Circuit easily was in the position to make this call without having to draw or ignore inferences or to marshall "facts." The patent and its prosecution history in this case were the controlling legal instruments, and the Federal Circuit was able to independently review these legal documents to decide if the district court's resort to extrinsic evidence was either justified or legal error under the circumstances. Based upon such documents, the district court was in no better position that the appellate court to decide the question of claim construction so as to warrant a more deferential standard of

review. *Cf. Salve Regina College*, 499 U.S. at 233. This is no different that an appellate court's *de novo* review of contracts, treaties, and other legal documents. *Barseback Kraft AB v. United States*, 121 F.3d 1475, 1479 (Fed. Cir. 1997)(*de novo review*); *Burnside-Ott Aviation Training Center v. Dalton*, 107 F.3d 854, 860 (Fed. Cir. 1997)("Whether a contract term is ambiguous is a question of law."). Thus, like the unsuccessful assertion of demeanor and credibility to support its argument that claim construction was a jury issue in *Markman*, 116 S. Ct. at 1395, Petitioners' assertions of credibility here to support deference to a trial judge's legal conclusion (Pet. at 26) stand on even softer ground.

While the Petitioners blithely assert that "the district courts that actually do the work know better" (Pet. at 26), they never tell the Court why, except to suggest the already rejected arguments of demeanor and credibility. As this Court recognized in *Markman*, the Federal Circuit is a specialized court in patent matters with the mandate of creating uniformity in decision. The Federal Circuit is the appropriate place to decide questions of law pursuant to traditional standards of *de novo* review. This the very decision reached by this Court in *Markman* in affirming the decision of the Federal Circuit in that case. This is particular true when, as in this case, there is no need for resort to extrinsic evidence and in fact consideration of such evidence would constitute legal error in light of the specifications and prosecution histories of the patents-in-suit.

III. The Federal Circuit Correctly Disregarded the Trial Court's Interpretation of "3% Elasticity" When the Patent Specifications and Their Prosecution Histories Expressly Specified a Contrary Meaning.

The fatal flaw in Petitioners' argument is that this particular case is the wrong vehicle for addressing the standard

of review question. As expressly recognized by Petitioners in Reason I.A., "The Federal Circuit May Not Disregard The Meaning Of A Claim Term To A 'Person Skilled In The Art' Unless The Patent Or Prosecution History Expressly Specifies A Contrary Meaning." (Pet. at 16). The problem for the Petitioners (and a fact essentially ignored in their brief) is that the Federal Circuit found that the patents-in-suit and their prosecution histories did expressly specify a meaning for "3% elasticity" which was different than that being advocated by Petitioners' expert at trial. Petitioners may not agree with the Federal Circuit's analysis, but the legal correctness of the Federal Circuit's review of the prosecution record of these specific patents does not create an issue worthy of review by this Court.

Although Petitioners contend that "[t]he Federal Circuit has made *irrelevant* both the meaning of claim terms to '*person[s] skilled in the art*' (rather than to judges) and the district court's determination of that meaning based on all the evidence at trial," Pet. at 13, that sweeping allegation simply cannot be reconciled with either the facts involved or the holdings set forth in the Federal Circuit's opinions. Indeed, as discussed below, the Federal Circuit has relied upon extrinsic evidence on a number of occasions to construe patent claims and has never suggested that parties should be precluded from introducing such evidence at trial. It likewise has never suggested that the district court judge should not be the judicial body charged with the duty of initially construing the patent claims or that a lower court's analysis, even if flawed, is of no assistance to the appellate court in reviewing the legal question of claim construction. What is at issue is not the utility of such efforts, but whether they should be binding on the Federal Circuit in all cases.

The problem for Petitioners in this case is that "elasticity" evidently does not have a fixed, uniform definition to one skilled in the art. While Petitioners' expert, Dr. Beshers, relied upon a chemical dictionary definition that defined it as "the ability of a material to recover its original shape partially or completely after the deforming force has been removed," C.A. App. 4208, he nonetheless conceded that a commonly accepted definition of "elasticity" was the ability of a stressed material to return to its original shape upon removal of the stress. (C.A. App. 4160-62). Other dictionary definitions similarly define "elasticity" as embodying the concept of complete recovery. (*See, e.g.*, C.A. App. 4158, 5235, 5296). As the district court noted based upon the testimony of Respondents' expert, "'there [are] as many definitions of elasticity as there are metallurgists'." (Pet. App. at 57a n.11) (quoting C.A. App. 5236). Yet, despite the fact that the term "elasticity" could, in the abstract, be susceptible to multiple meanings to a person of ordinary skill in the art, the inventors failed to expressly set forth the Beshers definition equating "elasticity" with "partial recovery" anywhere in their patent specifications.

While 35 U.S.C. § 112, ¶ 1, requires that the patent specification contain a written description of the claimed invention which would enable one of ordinary skill in the art to make and use the claimed invention (*see* Pet. at 16, 18), it is 35 U.S.C. § 112, ¶ 2, which requires that the specification contain one or more claims "particularly pointing out and distinctly claiming the subject matter which the *applicant* regards as his invention." [Emphasis added.] It is well established that a patentee can be his own lexicographer in using terms in his patent claims. *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563 (Fed. Cir. 1990), *cert. dismissed*, 499 U.S. 955 (1991). Moreover, an applicant cannot define a term one way during prosecution in order to avoid prior art and

obtain allowance of the patent and then advocate a different interpretation in litigation in order to establish infringement of the claim. *Lockwood v. American Airlines Inc.*, 107 F.3d 1565, 1573 (Fed. Cir. 1997).

As a result, as illustrated by the analysis set forth by the Federal Circuit in the recent *Bell & Howell* case, "[w]hen construing a claim, a court should look first to the intrinsic evidence, i.e., the claims themselves, the written description portion of the specification, and the prosecution history." *Bell & Howell,* 1997 U.S. App. LEXIS 34253 at 12; *see also Vitronics*, 90 F.3d at 1582-83. In most cases, "[t]he intrinsic evidence should usually be sufficient to enable one to determine the meaning of a claim term." *Bell & Howell,* 1997 U.S. App. LEXIS 34253 at 12. *See also Markman,* 52 F.3d at 986 (noting that "ideally there should be no ambiguity in claim language to one of ordinary skill in the art that would require resort to evidence outside the specification and prosecution history" and citing the disclosure requirements of 35 U.S.C. § 112 (1994) in support).

When the intrinsic evidence is not ambiguous, "it is improper for the court to rely on extrinsic evidence such as expert testimony for purposes of claim construction." *Bell & Howell*, 1997 U.S. App. LEXIS 34253 at 13. As explained in *Vitronics*, the rationale for this rule is that:

> The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design

> around the claimed invention. Allowing the public record to be altered or changed by extrinsic evidence . . . , such as expert testimony, would make this right meaningless. The same holds true whether it is the patentee or the alleged infringer who seeks to alter the scope of the claims.

90 F.3d at 1583 (quotations and citations omitted). "[I]t is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." *Markman*, 52 F.3d at 978 (citing *Merrill v. Yeomans*, 94 U.S. 568, 573-73 (1877), and *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848)).

As a result, once a dispute over claim construction arises, "experts" should not be "heard to inject a new meaning into terms that is inconsistent with what the inventor set forth in his or her patent and communicated, first to the patent examiner and ultimately to the public." *Bell & Howell*, 1997 U.S. App. LEXIS 34253 at 14. Instead, "[p]atents should be interpreted on the basis of their intrinsic record, not on the testimony of such after-the-fact 'experts' that played no part in the creation and prosecution of the patent." *Id. at 14-15; see also Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995)("[E]vidence extrinsic to the patent and prosecution history, such as expert testimony, cannot be relied on to change the meaning of the claims when that meaning is made clear by those documents."). Otherwise, it would be virtually impossible to ascertain the scope of a patent to any reasonable degree. Scope would depend upon the creativity of lawyers and so-called experts at trial and not on the meaning conveyed by the inventor in the patent.

The Federal Circuit in *Bell & Howell* took pains to make clear that "expert testimony to explain an invention may be useful," although such "reliance on extrinsic evidence to interpret claims is proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence, *Vitronics*, 90 F.3d at 1584, 39 USPQ2d at 1578, i.e., when the intrinsic evidence is 'insufficient to enable the court to construe disputed claim terms.'" *Bell & Howell*, 1997 U.S. App. LEXIS 34253 at 16 (quoting *Vitronics*, 90 F.3d at 1585). Thus, in cases where the meaning of claim terms was ambiguous or the patent record silent on the issue, the Federal Circuit had no objection to a district court's reliance on extrinsic evidence in the form of expert testimony or dictionary definitions to shed light on the meaning of such terms to those skilled in the art.[3]

Nothing in the Federal Circuit's opinion below suggests that such reliance is no longer appropriate. Rather, the Federal Circuit's opinion makes clear that it is was simply on the facts before it that made it "a case in which reliance on extrinsic evidence (e.g., expert testimony) is not necessary." (Pet. App. at 20a). Concentrating on the patent specifications and particularly the prosecution histories of the patents-in-suit, the Federal Circuit concluded that the inventors clearly intended "elasticity" to mean total or complete recovery prior to the onset of permanent deformation. Under the circumstances, and consistent with well-established case law, it was improper for the district court to rely upon extrinsic expert testimony which

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[3] *See, e.g., Eastman Kodak Co. v. The Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1555 (Fed. Cir. 1997); *United States Surgical Corp. v. Ethicon,* Inc., 103 F.3d 1554 , 1569 (Fed. Cir.), *cert. denied*, 118 S. Ct. 369 (1997); *Hoechst Celanese Corp. v. BP Chemicals Ltd.*, 78 F.3d 1575, 1579 (Fed. Cir.), *cert. denied*, 117 S. Ct. 275 (1996).

contradicted the meaning of "elasticity" which appears in the objective public record.

As noted above, one looks in vain in the patent and prosecution record to find any reference to Dr. Beshers' special definition of "elasticity" meaning "partial recovery." On the contrary, as observed by the Federal Circuit, the patent specifications consistently and repeatedly describe the "optimized elasticity" embodiment of claim 1 as operating "completely elastically," exhibiting "complete elastic spring back" and the like. (Pet. App. at 14a-15a, 21a). In particular, Figures 2F and 2H graphically illustrate the strain of the stretched frame returning to zero after the release of stress. (Pet. App. at 13a). See also the detailed discussion set forth in Section A.1. of Respondents' Counterstatement of the Facts. While perhaps not dispositive, such evidence is highly persuasive that the term "elasticity" in claim 1 was to be equated with the concept of "complete recovery."

Reference to the patents' prosecution history, however, removes any doubt on the question. In the course of correspondence and meetings with the patent examiner, the inventors through their patent attorney repeatedly represented that the "optimized elasiticity" invention set forth in claim 1 was illustrated by Figure 2H. (Pet. App. at 16a, 22a). It was specifically characterized as covering a frame which did not "deform" or "stay bent" when subjected to stress at low temperatures (C.A. App. 6952-54, 6961), a representation utterly with odds with Petitioners' current contention that the frame need not return to its original shape.

Most compelling of all are the representations made by the inventors' attorney during the reexamination of the '955 patent. The inventors reiterated that Figures 2F and 2H graphically depicted the elastic behavior of the frames of

"optimized elastic" embodiment of claim 1 and, as a result of such "optimized elasticity," that the strain would "spontaneously return to zero" when an applied stress was removed. (C.A. App. 6431-32, 6440).

In particular, to distinguish the claimed invention from the prior art Mercier reference, the inventors argued that Figure 2H showed how the frame material of claim 1 would behave at critical temperatures and expressly represented that "it can clearly be seen that the material is ***totally elastic*** when a stress of about 115 ksi is applied and removed." (Pet. App. at 22a; C.A. App. 6440; emphasis added). In contrast, the inventors maintained that the Mercier sample "clearly does not exhibit the properties shown in **Figure 2H** of the '955 patent when a load of 1150 N/mm^2 is applied and removed." (Pet. App. at 22a-23a; C.A. App. 6440; emphasis added). As correctly noted by the Federal Circuit, the only rational interpretation of the above is that the inventors were representing to the patent examiner that claim 1 relates to a frame "where there is total spring back to zero after the removal of a deforming force, as seen in Figure 2H of the patent." (Pet. App. at 23a).

If that were not clear enough, the inventors then expressly advocated a construction of "3% elasticity" in claim 1 as elasticity "***attainable prior to the onset of permanent deformation***" or else their recited elasticity property would be meaningless. (C.A. App. 6445; emphasis added). The Mercier material, in contrast, rather than returning "to its ***original shape,***" after the load was released, "would be ***deformed*** such that it exhibited 3% ***retained strain***" and would be "of no value." (C.A. App. 6445; emphasis added; *see also* Pet. App. at 17a-19a, 23a).

The inventors also submitted the Dieter textbook to the Patent and Trademark Office during the reexamination

proceedings which defined "elastic behavior" as "recover[y of the] original dimensions when the load is removed." (Pet. App. at 19a; C.A. App. 6518). Although Petitioners attempted to rely upon a more specialized definition of elasticity at trial, it is apparent that it was not the definition embraced by the inventors during patent prosecution and set forth in the public record.

In the light of such overwhelming evidence that the inventors adopted a "complete recovery" definition of the term "elasticity" during patent prosecution, the Federal Circuit correctly held that the trial court committed clear error in relying upon the extrinsic testimony of Petitioners' expert. Indeed, Petitioners' own expert admitted on cross-examination at trial that he had not reviewed the prosecution history and was unaware of the definitions of elasticity given by the inventors to the Patent and Trademark Office. (C.A. App. 4164.)

The Petitioners' only substantive response to this evidence was to attempt to create an ambiguity by focusing on portions of the record which related to the invention of claim 5. However, as the Federal Circuit correctly observed, the invention of claim 5, involving a combination of 3% heat-recoverable shape memory and 3% elasticity is a different invention than that recited in claim 1, which recovers its shape through elasiticity alone unaided by heat-recoverable shape memory. (Pet. App. at 23a). Having defined "elasticity" in claim 1 as requiring complete recovery, Petitioners cannot advocate a different interpretation for the same term in claim 5. *See Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632 (Fed. Cir. 1987).

IV. The Federal Circuit is Not Sharply Divided Over the Decision in This Case.

Contrary to the position advocated by Petitioners, the Federal Circuit is not sharply divided over the decision in this case. A petition for rehearing by the panel who decided this case was unanimously denied. Indeed, only one judge on the entire court, Circuit Judge Mayer, dissented from the denial of the suggestion for rehearing in banc, and then only on the standard of review issue which is not implicated by the facts of this case. It is should be noted that Judge Mayer was not a member of the original panel who heard this appeal or a member of the related Custom Optical appeal.

Circuit Judge Rader, the only other sitting Federal Circuit judge to echo Judge Mayer's views on the standard of review issue in the past,[4] clearly recognized that this case was not the vehicle in which to raise the standard of review issue and declined to join Judge Mayer in dissent.

Petitioners complain that the Federal Circuit's actions in a case such as this "fosters unpredictability." (Pet. at 29). A patent owner cannot ensure that a panel of the Federal Circuit will, in evaluating the public prosecution record as a matter of law, reach the identical claim construction proffered by the district court. However, there is far greater predictability

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[4] *See, e.g., J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563 (Fed. Cir. 1997)(Rader, J., dissenting). *See also Metaullics Sys. Co. v. Cooper*, 100 F.3d 938 (Fed. Cir. 1996), where in *dictum* Judge Mayer, joined by Judge Rader, asserted that the Federal Circuit "may" be required to defer the trial court's factual findings as part of a claim construction absent clear error. *Id.* at 939. Judge Lourie, concurring in part, however, noted that this Court did not criticize or overrule any aspect of the Federal Circuit's *in banc* opinion in *Markman*, and cautioned that subsequent panels would be bound by that *in banc* opinion. *Id.* at 940.

inherent in a system which places primary reliance at both the trial and the appellate level on the objective statements made by the inventors in their patent specifications and in their corresponding prosecution histories rather than on the self-serving, litigation-induced testimony of so-called experts at trial. Had the district court understood and properly interpreted the prosecution histories of the patents-in-suit, it is clear that the Federal Circuit would not have been compelled to reverse

CONCLUSION

The purpose of a writ of certiorari is not to correct the supposed factual misstatements or misunderstandings by the courts of appeals. Indeed, Respondents have already brought to the Federal Circuit's attention in a petition for rehearing, a suggestion for rehearing in banc, and a motion to supplement the record these same alleged "errors" made by the Federal Circuit panel. Those requests were summarily denied. (Pet. App. at 32a-36a, 110a-111a). Instead of presenting any true issues worthy of Supreme Court review, Petitioners essentially seek the same rehearing in this Court to correct what they perceive as factual mistakes in the Federal Circuit's opinion. For the foregoing reasons, the petition should be denied.

Respectfully submitted. January 9, 1998

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